



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER 077388, 079	FILING DATE 08/01/89	FIRST NAMED INVENTOR SATO	ATTORNEY DOCKET NO. R 3506297
------------------------------	-------------------------	------------------------------	----------------------------------

FITZPATRICK, CELLA, HARPER & SCINTO
277 PARK AVE.,
NEW YORK, NY 10172

EXAMINER
SHEHATA, R

ART UNIT 261	PAPER NUMBER 9
-----------------	-------------------

DATE MAILED: 07/29/91

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☐ This application has been examined ☒ Responsive to communication filed on 5/13/91 ☐ This action is made final.
- A shortened statutory period for response to this action is set to expire 3 month(s), - days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1, 3-6, 9-17 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 2 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1, 3-6, 9-17 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☒ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☒ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Art Unit 261

1. The indicated allowability of claims 6, 15-17 is withdrawn in view of the newly discovered prior art to Ikehata et al., a German document submitted by applicant. The delay in citation of this art is regretted. Rejections based on the newly discovered prior art follow.

2. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

3. Claims 1, 3-6, 9, 10, 12-17 are rejected under 35 U.S.C. § 103 as being unpatentable over Ikehata et al. in view of May et al. in further view of Sekiya et al.

Ikehata et al. teaches a word processor combined with a facsimile apparatus. May et al. discloses a telephone set with an automatic dialer. And Sekiya et al. teaches a facsimile that reads and recognizes character data. The claims differs from the combination of the teachings above in that they claim the combination of the above teachings, more specifically the claims claim an information processing unit that includes a programmable dialer that is programmed by reading means that reads and recognizes telephone numbers. Then, according to a phone number selected by using the

Art Unit 261

dialer, a document, retrieved from a storage medium, is transmitted over the telephone lines. It would have been obvious to one of ordinary skill in the art to combine the apparatus taught by Ikehata et al. with the automatic dialer taught by May et al. since the combination would provide a more convenient apparatus in the sense that the automatic dialer would store all the dial information character code so that the user would not have to follow the complicated procedure of dialing a telephone number as disclosed in Ikehata et al. more than once. Furthermore, it would have been obvious to one of ordinary skill in the art to incorporate the facsimile taught by Sekiya et al. into the combination of Ikehata et al. and May et al. in order to ease the programming procedure required to program the automatic dialer thereby completely eliminating the complicated method of dialing taught by Ikehata et al.

Referring to claim 1 and figure 1 of Sekiya et al., the reading means is read on scanning section 4. The recognizing means for recognizing the character data is read on recognition section 2. The registering means is read on CPU 6. Referring to claim 1 and May et al., the searching means is read on controls 80a and 80b of figure 2. The display means is read on display 20 of figure 1. It would have been obvious to display the image information read so that the user would be informed as to what has been read. It also would have been obvious to display the recognized data so that the user would be assured that the correct number is being dialed or stored. The selecting means is read on light pen 30. The control means is read

Art Unit 261

on control circuit 42. The storage means, is not disclosed in Ikehata et al., however, it is considered inherent since storage means is an essential element in word processors. The step of transmitting a stored document is disclosed in Ikehata et al. whereas the telephone number is searched and dialed by the automatic dialer.

In claim 3, it would have been obvious to register characters in the registering means in accordance with the type of character data in order to sort the read data, the names and their associated phone numbers, in a particular order to ease the search procedure.

Considering claim 4, applicant is directed to the arguments of claim 1. Furthermore, it would have been obvious to display the stored or registered data characters in a certain order (e.g. alphabetically) such that the searching process would be an easy task. The means for correcting and changing the character data is read on light pen 30 in use with display 86 of figure 3.

In claim 5, the control means is read on control circuit 42. The user searches for the desired phone number using controls 80a and 80b the selects one of the plurality of the displayed phone numbers using the light pen, then the phone number is automatically dialed. See column 6 lines 60-68.

For claim 9, applicant is directed to the arguments of claim 5.

For claim 10, it would have been obvious to place the facsimile of Sekiya et al. on the upper surface of the telephone set taught by May et al., since it is an obvious choice of design.

As for claims 12-17, applicant is directed to the arguments on claims 1, 3, 5, 1, 3, 1 respectively.

Art Unit 261


4. Claim 11 is rejected under 35 U.S.C. § 103 as being unpatentable over Ikehata et al. in view of May et al. in further view of Sekiya et al. as applied to claims 1, 3-6, 9-17 above, and further in view of the publication titled "The front, a hand held computer."

May et al. teaches the use of a CRT in combination with a light pen. However, the publication shows the use of a touch sensitive LCD. Therefore, it would have been obvious to substitute the CRT of May et al. with a touch sensitive LCD since it would decrease the amount of hardware required to build the telephone set taught by May et al. (e.g. the light pen could be eliminated). Also, LCDs are space and power efficient.

5. Applicant's arguments with respect to claims 1, 3-5, 9-14 have been considered but are deemed to be moot in view of the new grounds of rejection.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Magdy W. Shehata whose telephone number is (703) 308-4969.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0962.


JAMES L. DWYER
PRIMARY EXAMINER
ART UNIT 261

MS

Magdy W. Shehata
July 25, 1991